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EXAMINER

BOMBERG, KENNETH

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,014	Applicant(s) MIHASHI ET AL.	
	Examiner KENNETH BOMBERG	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 21, 2010 has been entered.

Response to Amendment

2. The amendment to the claims filed on July 21, 2010 does not comply with the requirements of 37 CFR 1.121(c) because the claim identifiers and markings do not accurately reflect the status of the claims. Specifically the amendments to claims 1-3 are identical to those entered in the amendment filed July 2, 2009, thus should not contain text markings and should use the identifiers (Previously presented) rather than (Currently Amended).

Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

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(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) Reinstatement of previously canceled claim. A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

None the less, the amendment has been entered and the claims treated on merit. To be complete, any response to this office action requires a new listing of claims in compliance with 37 CFR

1.121. Future responses which do not comply with 37 CFR 1.121(c) will be held non-responsive.

Information Disclosure Statement

3. The information disclosure statement filed July 21, 2010 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because for each US Patent listed the inventor and issue date has been omitted (37 CFR 1.98(b)(1)); and for each Foreign Patent or Published Foreign Patent Application the publication date has been omitted (37 CFR 1.98(b)(4)). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0130139 to Shiraishi et al. (Shiraishi) in view of US Patent 5,497,910 to Meadows et al (Meadows).

In Reference to Claim 1

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Shiraishi teaches:

A discharging container with a filter (1) comprising:

a bottle (2) which is formed in a manner wherein an inner layer (22) peelable from an outer layer (21) is formed on an inner surface of the outer layer;

a plug body (3) placed on a mouth portion (2a) of the bottle; and

a filter provided (7) in a discharging pass (10) which is provided in the plug body for discharging liquid kept in a body of the inner layer;

Shiraishi further teaches:

a dispensing valve (8) has a memory which expands the valve in a manner wherein a difference between an inner negative pressure and an ambient air is higher than a filtration resistance of the filter (see page 6, [0075] last 7 lines); and

the negative pressure is caused by the memory of the valve (8) and by that liquid remained in a second side of the filter is sucked into a primary side of the filter (see [0043] and [0053]).

Shiraishi differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into a primary side of the filter rather than the memory of inner layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]).

Meadows teaches:

In Figs. 1-3 of a dispenser similar to that of applicants' and Shiraishi to make an

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inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a “suck back” vacuum (see col. 4, lines 57-62; col. 5, lines 35-43).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teaching of using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows in the dispenser of Shiraishi because doing so would allow the suck back function to be performed without the use of a resilient valve.

Further the application of the teaching of Meadows to Shiraishi constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. ___, 82 USPQ2d 1385

In Reference to Claim 2

See Shiraishi [0067].

In Reference to Claim 3

See Shiraishi Fig. 1.

In Reference to Claim 4

Shiraishi teaches to make the inner layer (22a,b) of a synthetic resin (plastic [0060]) as does Meadows (low density polyethylene; col. 5; ll. 40-41). However the average thickness of the inner layer being over 0.35 mm is not taught.

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Meadows does however explicitly teach:

“Wall thickness of the inner and outer bottles 30, 12 is of importance in the operation of the dispensing system 10. In this regard the wall thickness will, of course, depend not only on the surface tension of the formulation, but on bottle 30, 12 material, size and shape.” (col. 5, ll. 30-34).

Consequently, Meadows explicitly teaches that the inner layer wall thickness is an art recognized results effective variable to be selected based on the surface tension of the formulation, and on bottle 30, 12 material, size and shape. Thus it would have been obvious to one having ordinary skill in the art at the time of the invention to have selected the inner layer thickness to be over 0.35 mm through routine experimentation to optimize dispensing characteristics for a given formulation and bottle of selected material, size and shape as the optimization of an art known results effective variable would have been within the ordinary level of skill in the art as taught by Meadows.

Response to Arguments

6. Applicant's arguments filed July 21, 2010 have been fully considered but they are not persuasive.

Receipt of the Information Disclosure Statement (IDS) filed July 21, 2010 is acknowledged. As the IDS fails to comply with 37 CFR 1.98(b)(2) and (4). It has been placed in the application file, but the information referred to therein has not been considered as to the merits (See MPEP 609).

In response to the Examiner's notification that the listing of references in the specification is not a proper information disclosure statement, Applicant argues that the examiner is required to read and consider all of the disclosure in the application, including the prior art disclosed and discussed in the application. The disclosure has been considered including Applicant's description of the background art; however, considering Applicant's description of a reference is not equivalent to considering the reference itself. Consequently references which were not indicated as being considered in the Notice of References Cited or the Information Disclosure Statement have not been considered.

On pages 5-6 of the arguments, applicants argue Shiraishi et al. and Meadows et al individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's state at page 7: "Nowhere apparently does Shiraishi et al. disclose or suggest the (claimed) expanding memory feature of the inner layer". This statement is factually incorrect; Shiraishi et al. clearly indicates the bag / inner layer (22) is made of a synthetic resin made of a resilient material (see [0057] and [0060]) which as described has a "memory". Meadows provides the further teaching to provide such a bag /inner layer with sufficient resilience to result in a suck back effect.

On pages 7-8, the applicant argues that "The Examiner has not factually resolved the level of ordinary skill in the art so the Examiner has no basis in the record for asserting/stating what would be obvious to one ordinarily skilled in the art." Although it is not clear what

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precisely is meant by this statement as applied to the rejection of record, as best understood it appears to be based on a misconception of the requirement for deterring the level of ordinary skill in the art. Applicant's attention is directed to MPEP 2121.03 which states:

The "hypothetical" person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art." *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988) (The Board disagreed with the examiner's definition of one of ordinary skill in the art (a doctorate level engineer or scientist working at least 40 hours per week in semiconductor research or development), finding that the hypothetical person is not definable by way of credentials, and that the evidence in the application did not support the conclusion that such a person would require a doctorate or equivalent knowledge in science or engineering.); and

If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

In the rejection of record, the prior art itself is directed to the same field of endeavor (dispensing containers), and clearly indicates that one having ordinary skill in this art understands that a container can be configured to provide a suck-back feature through a dispensing outlet and a dispensing outlet having a filter, and further that the resilience of an inner container may be used to create this suck-back effect. In view of the above, it is unclear how the rejection could be construed as being deficient in ascertaining the ordinary level of skill in the art.

It is further argued that rejection fails to factually establish "predictable results" when applying the teaching of Meadows to Shiraishi and the rejection therefor is based on forbidden hindsight. As with the previous argument, it is not clear what precisely is meant by this statement as applied to the rejection of record. The teachings of Meadows in using the resilience of the inner container to obtain the suck back effect are clear. Similarly, the fact that Shiraishi

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includes a resilient inner container but discloses the valve as being used to obtain the desired suck back is also clear. What exactly is unpredictable about applying the Meadows teaching of using the inner bag to assist or obtain the desired suck back in Shiraishi is unclear. The level of ordinary skill in the art as demonstrated by Shiraishi and Meadows clearly indicates that making an inner bag which is already disclosed as being resilient (by Shiraishi) sufficiently resilient to assist / perform the suck back function as explicitly taught by Meadows would produce the desired results through routine experimentation.

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH BOMBERG whose telephone number is (571)272-4922. The examiner can normally be reached on Monday-Thursday and alternative Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571)272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth Bomberg/
Primary Examiner, Art Unit 3754
KB